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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,992	01/16/2004	Naoya Morozumi	K-2140	5003

7590 07/22/2004

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Alexandria, VA 22314

EXAMINER

TRIEU, THERESA

ART UNIT PAPER NUMBER

3748

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/757,992

**Applicant(s)**

MOROZUMI, NAOYA

**Examiner**

Theresa Trieu

**Art Unit**

3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 16, 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Receipt and entry of Applicant's Preliminary Amendment filed on January 16, 2004 is acknowledged.

#### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement (see page 2, [0010] paragraph, line 24). 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

#### ***Drawings***

2. Figures 4 and 5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The abstract of the disclosure is objected to because the abstract includes reference characters which are not enclosed within parentheses. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Background Graham v. John Deere Co***

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 3748

**4. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art (Fig. 5) in view of Takada (Publication Number JP 04-365983).**

Regarding claims 1 and 3, as shown in Fig. 5, admitted prior art discloses a scroll compressor in which the interior of a closed shell is divided into a compression chamber (CC) and an electric motor chamber (MC) by a main frame (3); and a rotational drive shaft (6) is provided to transmit a rotational driving force generated in the electric motor chamber into the compression chamber (CC); wherein the rotating drive shaft has a main shaft (61) arranged coaxially in the electric motor chamber and a crankshaft (62) for revolving an orbiting scroll in the compression chamber (CC); the crankshaft is arranged so that the eccentricity  $e$  with respect to the main shaft has a relation of  $e > (D_m - D_c) / 2$  with  $D_m$  being diameter of the main shaft and  $D_c$  being the diameter of the crankshaft; a sub frame (7) for supporting the other end of the rotational drive shaft; and the other end of the drive shaft (6) is pivotally supported in the thrust direction via the sub-frame (7). However, admitted prior art fails to disclose a joint shaft is between the main shaft and the crankshaft.

As shown in Fig. 3, Takada teaches that it is conventional in the art to utilize a joint shaft (not numbered; however, clearly seen in Fig. 3) being provided between the main shaft (9) and the crankshaft (90); the joint shaft has a shape which falls within the diameter  $D_m$  of the main shaft and within the diameter  $D_c$  of the crankshaft when viewed in the axial direction. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the joint shaft, as taught by Takada in the admitted prior art apparatus, since the use of thereof would have improved the performance and the efficiency of the scroll compressor device. Applicant should also not that where a product by process claim is rejected over a prior

Art Unit: 3748

art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an obvious difference between the two. *See In re Marosi, 218 USPQ 289* (Fed.Cir. 1983). Accordingly, the manner by which the joint shaft having a length corresponding to a machining relief does not result in any different structure that shown by the applied prior art.

***Allowable Subject Matter***

5. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and consists of five patents.

Hoshimo et al. (Patent Number 5,304,045) disclose a closed type motor-driven compressor, a scroll compressor and a scroll lap machining end mill.

Haeda et al. (Publication Number JP 59-113290) disclose oil supplying device enclosed type scroll compressor having a crankpin and main shaft.

Arata et al. (Publication Number JP 60-178988) disclose a scroll fluid device.

Takebayashi et al. (Publication Number JP 04-54296) discloses a scroll compressor having lubricating oil in the shaft.

Art Unit: 3748

***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 703-308-6434. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E Denion can be reached on 703-308-2623. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TT



Theresa Trieu  
Patent Examiner  
Art Unit 3748